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EXAMINER

MITCHELL, NATHAN A

ART UNIT	PAPER NUMBER
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2617

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PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/023,704	Applicant(s) TIPNIS ET AL.	
	Examiner NATHAN MITCHELL	Art Unit 2617	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 10 March 2009.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 3 and 13-31 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 3, 13-27 and 29-31 is/are rejected.
- 7) ☒ Claim(s) 28 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Claims 3 and 13-31 are pending.

Information Disclosure Statement

1. The information disclosure statements (IDS) submitted on 8/17/2009, 10/05/2009, 12/17/2009 and 2/02/2010 have been considered.
2. The information disclosure statements dated 12/19/2007, 1/11/2008 and 4/22/2008 referenced in the response have also been considered.

Response to Arguments

3. Applicant's arguments are moot in view of the new ground(s) of rejection.

Claim Objections

4. Claims 3 and 31 is objected to because of the following informalities: "subscriber device" should be changed to "wireless device". Similar problems exist in claim 31 (and may exist elsewhere too). Claim 29 also doesn't make a lot of sense as written. The examiner will interpret it consistent with claim 28. Appropriate correction is required.
- 5.

Claim Rejections - 35 USC § 112

6. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

7. Claims 13-30 rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one

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skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. Simply put nowhere in the specification or original claims does the word internet protocol occur once. SMS protocol is addressed based on phone numbers (see <http://www.dreamfabric.com/sms/>). Also, the examiner fails to see support for claim 15. The only mention of an SMSC is in paragraph 20, which basically just states that there is one in the system. Nothing is mentioned about anything being maintained. The one possible point of support for the claim is original claim 4, which says that the message is maintained in a short messaging system. Well obviously a "short messaging system" is not synonymous with an SMSC. Perhaps the specification is being misinterpreted by applicant as the more plausible thing to map "short messaging system" to is element 105 as it actually has the tour guide information. For the purposes of examination, the examiner will interpret the claim to be consistent with an SMS message being routed through an SMSC in the conventional manner. Claim 22 has the same problems as claims 15.

8.

Claim Rejections - 35 USC § 103

9. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

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10. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

11. Claims 3 rejected under 35 U.S.C. 103(a) as being unpatentable over 2002/0183072 A1 to Steinbach in view of 2003/0155413 A1 to Kovesdi et al. and 2003/0022664 A1 to Goldstein.

Regarding claim 3, Steinbach discloses:

Establishing a wireless device initiated information session with the wireless device (30 and see paragraph 43).

Obtaining a location of the subscriber device (32)

Identifying content relating to the location (33)

Transmitting the identified content to the wireless device (34)

Regarding claim 3, Steinbach fails to disclose:

the content being in the form of short messages; and

increasing a wireless airtime unit usage for a time of use of the information session.

However in an analogous art, Kovesdi et al. discloses providing location related information to a user over SMS (paragraph 99). It would have been obvious to one of

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ordinary skill in the art at the time of invention to combine this teaching with that of Steinbach et al. by using SMS protocol to transfer tour information. The motivation for the combination is simple substitution of one element for another to yield predictable results. *KSR International Co. v. Teleflex Inc.*, 550 U.S.---, 82 USPQ2d 1385 (2007). Steinbach discloses a device which differs from the claimed invention in how information is conveyed. Steinbach and Kovesdi disclose differing methods of conveying information. One of ordinary skill in the art could have substituted one for the other. The substitution would have been predictable since both disclosures are in the field of mobile communications.

Steinbach as modified fails to disclose:

increasing a wireless airtime unit usage for a time of use of the information session.

However in an analogous art, Goldstein discloses charging fees based on the duration of a cellular data session (paragraph 6). It would have been obvious to one of ordinary skill in the art at the time of invention to combine the teachings of Goldstein with those of Steinbach as modified by measuring the duration of a data session (reading on increasing the airtime unit usage). The motivation for the combination is the knowledge of one of ordinary skill in the art that service providers need to charge fees to see return on a capital investment.

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Claim 31 is rejected based on the same rejection of claim 3. The examiner additionally cites paragraph 18 as further evidence that the location is determined relative to a guidance location.

12. Claims 13 and 20 are rejected under 35 U.S.C. 103(a) as being unpatentable over Steinbach in view of Kovesdi and Goldstein as applied to claim 3 above, and further in view of U.S. Patent No. 6487602 B1 to Thakker.

Regarding claim 13, Steinbach as modified in the rejection of claim 3 discloses all the subject matter of the claimed invention with the exception of the short message instead being an IP message. In an analogous art, Thakker discloses SMS/IP translations in effecting communication between a server and a mobile terminal (column 2 1-35). It would have been obvious to one of ordinary skill in the art at the time of invention to combine this teaching with that of Steinbach by using an internet-based server to store IP tour messages. The motivation for the combination is to access the internet without the need for an attached computer (column 1 65-67).

Claim 20 is rejected for the same reason as claim 13. Clearly the messages are tour guide information.

Regarding claim 27, Steinbach discloses a server as the source of the content (paragraph 15), which as modified reads on the claimed short message system to maintain the IP message.

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13. Claims 14 and 21 rejected under 35 U.S.C. 103(a) as being unpatentable over Steinbach in view of Kovesdi, Goldstein and Thakker as applied to claim 13 above, and further in view of 6038444 to Schipper.

As written determining the speed of the mobile terminal has nothing to do with anything. Steinbach as modified fails to disclose determining the speed. In an analogous art, Schipper discloses determining the velocity of a phone (column 3 50-67). It would have been obvious to one of ordinary skill in the art at the time of invention to combine this teaching with that of Steinbach as modified to improve cellular experience (column 2 53-67).

Claim 21 is rejected for the same reason as claim 14.

14. Claims 15 and 22 are rejected under 35 U.S.C. 103(a) as being unpatentable over Steinbach in view of Kovesdi, Goldstein and Thakker as applied to claim 13 above, and further in view of common knowledge.

The examiner explained how the claim is being interpreted in the 112 1st rejection.

Regarding claim 15, Steinbach as modified fails to disclose the SMS transiting through an SMSC (i.e. being "maintained"). However the examiner takes official notice that it was well known in the art at the time of invention to route SMS messages using SMSCs. Thus it would have been obvious to one of ordinary skill in the art at the time of invention to combine this teaching with that of Steinbach as modified in order to effect a delivery of an SMS content.

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Claim 22 is rejected for the same reason as claim 15.

15. Claims 16-19 and 23-26 rejected under 35 U.S.C. 103(a) as being unpatentable over Steinbach in view of Kovesdi, Goldstein and Thakker as applied to claim 13 above, and further in view of Applicant's Admitted Prior Art (AAPA).

Regarding claims 16-19, Steinbach further discloses using the cellular network to determine location (paragraph 41). However applicant discloses all the techniques of localization addressed in claims 16-19 are known in the prior art (paragraph 23). It would have been obvious to one of ordinary skill in the art at the time of invention to combine any of those teachings with Steinbach as modified. The motivation for the combination is simple substitution of one element for another to yield predictable results. *KSR International Co. v. Teleflex Inc.*, 550 U.S.---, 82 USPQ2d 1385 (2007). Steinbach as modified differs from the claimed invention in how the location is determined. Several methods are known in the art. One of ordinary skill in the art at the time of invention could have substituted one method for another. The substitution would have been predictable since the localization techniques of Steinbach and the prior art are analogous.

Claims 23-26 are rejected for the same reason as claim 16-19.

Allowable Subject Matter

16. Claims 28 would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

17. Claims 29 and 30 would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims and if applicant is

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somehow able to convince the examiner the 112 1st rejection is improper. Claim 29 must also be re-written to reflect how the examiner is interpreting it (see claim objection).

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to NATHAN MITCHELL whose telephone number is (571)270-3117. The examiner can normally be reached on M-F 8:30-5.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Lester Kincaid can be reached on (571)272-7922. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Nathan Mitchell/
Examiner, Art Unit 2617